

REMARKS

This communication is in response to the nonfinal Office Action issued October 23, 2002. The Examiner restricted the claims into Group I (claims 1 and 11-13) and Group II (claims 2 and 14-23), with Group II being subdivided into species A-G. The Examiner rejected claims 2, 14, and 15 under 35 U.S.C. § 102 in view of U.S. Patent No. 3,435,500 to Aser *et al.* (Aser). The Examiner rejected claims 2 and 14-16 under 35 U.S.C. § 103 in view of Aser in combination with one or more of U.S. Patent Nos. 5,685,944 to Nose *et al.* (Nose) and WO 99/30913 to Reil *et al.* (Reil).

Election/Restriction

In sections 1-7, the Examiner restricted the claims into Group I (claims 1 and 11-13) and Group II (claims 2 and 14-23), with Group II being subdivided into species A-G. It is noted that the Examiner indicated that claim 14 is a generic claim. The Applicants previously elected Group IIA (claims 2 and 14-16) for examination in the instant application. The Applicants hereby affirm the election of these claims.

Claim Rejections Under 35 U.S.C. § 102

In sections 8 and 9 of the Office Action, the Examiner rejected claims 2, 14, and 15 under 35 U.S.C. § 102 in view of Aser.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of claims 2 and 14-16 do not satisfy this burden.

Aser appears to disclose a pressure roller suitable for use in a heated contact fusing device (column 2 lines 70-72). The pressure roller includes “a steel core to which silicone rubber is bonded” (column 3 lines 7-8). An outer sleeve of an “abhesive material” is added over the silicone rubber by an adhesive and heat shrinking of the sleeve (column 3 lines 8-13).

The present application, conversely, discloses and claims in amended claims 2 and 14 a method of producing a small diameter roller for use with a transfer head of a film transfer tool comprising *inter alia* providing a core material containing a shaft in which the shaft is thinner towards the ends than between them. Support for this recitation is seen, for example, at page 13 line 8 of the written description. There is no teaching or suggestion of such a shaft in Aser. Therefore, claims 2 and 14-16 are allowable over Aser.

In view of the foregoing, the Examiner’s rejection under 35 U.S.C. § 102 to claims 2, 14, and 15 is believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103

In sections 10-12 of the Office Action, the Examiner rejected claims 2 and 14-16 under 35 U.S.C. § 103 in view of Aser in combination with one or more of U.S. Patent Nos. 5,685,944 to Nose *et al.* (Nose) and WO 99/30913 to Reil. Specifically, the Examiner rejected claims 2, 14, and 15 in view of Aser modified by Nose, and claims 2 and 14-16 in view of Aser modified by Reil¹.

It is well settled that for a rejection of a claim under 35 U.S.C. §103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example,

¹ While the October 23, 2002 Office Action does not specifically address which claims were rejected in section 12 of the Office Action, Examiner Richard Crispino stated in an October 28, 2002 telephonic interview that section 12 was directed to claims 2 and 14-16.

MPEP §2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP §2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP §2143.01. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP §2143. For at least the reasons stated below, the Examiner's rejections of claims 2 and 14-16 do not satisfy these burdens.

As discussed above, the present application discloses and claims a method of producing a small diameter roller for use with a transfer head of a film transfer tool comprising *inter alia* providing a core material containing a shaft in which the shaft is thinner towards the ends than between them. Also as discussed above, Aser does not teach or suggest such a method. Neither Nose nor Reil satisfy the shortcomings of Aser. Therefore, claims 2 and 14-16 are allowable for at least the same reasons as discussed above.

In view of the foregoing, the Examiner's rejection under 35 U.S.C. § 103 to claims 2 and 14-16 is believed to be overcome.

Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 18920.0019).

Conclusion

Claims 2 and 14 have been amended. Claims 1, 2, and 11-23 are pending in the application, with claims 1 and 17-23 being drawn to an unelected group or species. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



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APPENDIX A:

MARKED-UP COPY OF THE AMENDED CLAIMS

1 2. (Amended) A method for producing a small diameter roller for use for a transfer head
2 of a film transfer tool, said roller having a shaft and said shaft being elongate and having two
3 ends, said shaft being thinner towards said ends than between said ends, in which said small
4 diameter roller is produced by placing a heat shrinkable tube over a core material and heating
5 said tube so that said heat shrinkable tube shrinks to cover said core material.

1 14. (Amended) A method of producing a small diameter roller for use with a transfer head
2 of a film transfer tool, comprising:
3 providing a core material containing a shaft of sufficient strength for use in a film
4 transfer tool, said shaft being elongate and having two ends, said shaft being thinner towards
5 said ends than between said ends; and
6 placing a resilient member uniformly around said shaft.